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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
JABR, FADEY S	

ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/963,812	SCHLEICHER ET AL.	
	Examiner	Art Unit	
	FADEY JABR	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1-29* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1-29* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

12)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/7/11*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

A summary of the Board of Patent Appeals and Interference's decision:

The Examiner did not err in rejecting claims 28 and 29 under 35 U.S.C. § 103(a).

The Examiner did not err in rejecting claims 1-27 under 35 U.S.C. § 103(a) as 1-27 provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

We conclude the Examiner erred in rejecting claims 1-27 under 35 U.S.C. § 103(a).

We enter a new grounds of rejection of claims 9-16 and 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims **1-29** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's amendments filed 24 June 2011 with respect to the 35 U.S.C. 112, second paragraph, have been fully considered and is therefore withdrawn. The examiner notes that the applicant's amendments have instead introduced a 35 U.S.C. 101 rejection for software per se. Rejection is explained below.

2. Applicant's arguments with respect to claims **1-29** have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims **1-27** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **16 and 17** of copending Application No. 09/814319 in view of Ferguson et al., U.S. Patent No. 5,819,092.

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims **16 and 17** of Application No. 09/814319 recite:

A peer-to-peer file delivery network, comprising:

- at least one server node;
- multiple client nodes coupled to the server node over the network, each of the client nodes running a client application, wherein the client application works and operates in conjunction with the server node to enable secure and reliable peer-to-peer file sharing between two client nodes by,

enable secure and reliable peer-to-peer file sharing between two client nodes by,

- generating account information for a user of each client node, including a digital certificate, in response to a registration process, wherein the digital certificate includes a private key and a public key,

- in response to a file being selected for publication on a first client node by a first user,

- generating and associating a digital fingerprint with the file,

- generating a bitstream ID for the file and including the bitstream ID in the fingerprint, and

- using the user's private key to generate a digital signature from the file and including the digital signature in the fingerprint.

adding an entry for the file to a search list of shared files on the server

- node and storing the fingerprint on the server,

- in response to a second client node selecting the file from the search list on the server node, automatically transferring the file from the first client node directly to the second client node, and

- authenticating the file by the second client node by generating a new bitstream ID, comparing the new bitstream ID to the bitstream ID in the fingerprint stored on the server, and using the user's public key to decrypt the digital signature to determine the authenticity and reliability of the file and publisher.

The network of claim **17** wherein the client application operates in conjunction with the server node to enable subscription-based decentralized file downloads to the client nodes by

- allowing the client nodes to subscribe with the server node to periodically receive copies of one of the files,

- when providing a current subscribing client node with the file, locating the closest

client node containing the file, and

- transferring the file from the closest node directly to the current subscribing node, thereby efficiently utilizing bandwidth.

Claims **16 and 17** of Application No. 09/814319 differs since it further recites additional claim limitations including generating account information for a user of each client node, including a digital certificate; authenticating the file by the second client node by generating a new bitstream ID; and allowing client nodes to subscribe with the server node to periodically receive copies of one of the files. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 by removing the limitations directed to generating account information, authenticating a file using a bitstream, and allowing client nodes to subscribe with the server node resulting generally in the claims of the present application since the claims of the present application and the claims recited in Application No. 09/814319 actually perform a similar function. It is well established that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before.

Also, claims **16 and 17** of Application No. 09/814319 differ since they fail to recite a method for charging a fee to providers and users of the subscription-based content, either for serving the subscription-based content to the users or for receiving the content. Ferguson et al. teaches a method for levying fees against both users and content providers in an online system (C. 4, lines 53-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claims **16 and 17** of Application No. 09/814319 and include the method of charging a fee to providers and users of the subscription-based content as

taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability for the service.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims **1-8** and **25-26** are rejected under 35 U.S.C. 101 because based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) **1-8** and **25-26** held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below: insufficient recitation of a machine or transformation. Involvement of machine, or transformation, with the steps is merely nominally, insignificantly, or tangentially related to the performance of the steps, e.g., data gathering, or merely recites a field in which the method is intended to be applied. In this particular instance, the initiating on one client node….allowing client nodes…, are considered to be mere nominal recitations of a machine.

7. Claims **17-24** require a computer readable store medium, which stores a program. The specification does not set forth what constitutes a computer readable medium, and therefore , in view of the ordinary and customary meaning of computer readable media and in accordance with the broadest reasonable interpretation of the claim, said medium could be directed towards a transitory propagating signal per se and considered to be non-statutory subject matter. See *In re Nuijten, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. 101, Aug 24, 2009, p. 2.* Claims that

recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101. Please refer to MPEP 2111.01 and the USPTO's "Subject Matter Eligibility of Computer Readable Media" memorandum dated January 26, 2010, http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims **1-6, 9-14, 17-22** and **26-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci, Pub. No. US2002/0062290 A1 in view of Janik et al., Pub. No. US 2011/0178616 A1 and Ferguson et al., U.S. Patent No. 5,819,092, hereinafter referred to as Ricci, Janik and Ferguson, respectively.

As per **Claims 1, 9, 17 and 29**, Ricci discloses a method and system comprising:

(a) enabling peer-to-peer file sharing of content by,

- (i) initiating on one client node a download of a particular content item served from the server node or another client node (0030-0033), and

- (ii) charging a fee based on a quantity of the content served (0022, 0053); and

(b) enabling decentralized downloads of subscription-based content by

- (i) allowing the client nodes to subscribe to one or more of the subscription-based content (0057, 0061).

Ricci fails to disclose (ii) periodically sending the subscribed to subscription-based content to each the respective subscribing client nodes. Ricci discloses that collecting royalties without charging subscription fees is an alternative form of levying fees. Ricci actually discloses that the royalty may be a traditional charge (i.e. subscription fees or any other form of charging a user) (00 30). Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Janik teaches Subscription is defined to mean a content service whereby new content is periodically provided based on a content selection parameter, such as a particular artist, editorialist, or genre. Subscription services may be paid for by the user or can be ad-supported (free to the user). An example of a subscription service is an audio sports news file that is downloaded to a user's PC every day (see at least 0044-00445, 0065, 0083-0084). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Ricci and include providing clients subscription based content on a regular basis as taught by Janik, because it provides clients with their desired content on a predictable scheduled timeframe easily and conveniently onto their computer.

Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. As stated above, Examiner notes that Ricci does disclose

charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Ferguson et al. teaches levying fees on content providers for transactions with the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service by generating a predictable revenue stream.

As per **Claims 2, 10, 18**, Ricci further discloses a method of providing direct marketing by sending marketing content to the client nodes from the server node as well as from other client nodes (0065, lines 1-8). Ricci fails to disclose charging a fee to providers of the marketing content. However, Ferguson et al. teaches charging a fee to providers of the marketing content (C. 14, lines 30-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging marketing content providers a fee as taught by Ferguson et al. because charging marketing content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 3, 11, and 19**, Ricci further discloses a method enabling client nodes to become affiliate servers that deliver content to other client nodes (0030). Ricci fails to disclose paying owners of the affiliate servers a percentage of the fee charged for serving the files. However, Ferguson et al. teaches paying the user of the service (C. 9, lines 2-9). Therefore, it

would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include paying users of the affiliate servers a portion of the fee charged for serving the files as taught by Ferguson et al. because paying owners of the affiliate servers would increase retention of the affiliate server owners.

As per **Claims 4-6, 12-14, and 20-22**, Ricci further discloses a method including the steps of charging a fee from a user of the initiating client node for the download of the fee-based content (0022, 0053). Ricci fails to disclose charging a fee from a provider of the free content for serving the free content. However, Ferguson et al. teaches charging content providers a fee (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci to include charging content providers a fee for serving the free content as taught by Ferguson et al. because charging content providers a fee would greatly increase profitability of the file sharing service.

As per **Claims 26-28**, Ricci discloses a system and system comprising:

- enabling peer-to-peer file sharing of content whereby one client node initiates a download of a particular content item served from the server node or another client node (0018), and
- wherein a fee is charged based on a quantity of the content served (0022, 0053);
- providing direct marketing to client nodes such that marketing content is send to the client nodes from the server node as well as from other client nodes (0065, lines 1-8),

- enabling client nodes to become affiliate servers that deliver content to other client nodes (0030),

Ricci fails to disclose: enabling decentralized downloads of subscription-based content that the client nodes subscribe to in order to receive periodic updates, wherein a fee is charged to providers of the subscription-based content for serving the subscription-based content to the client nodes; owners of the affiliate servers are paid a percentage of the fee charged for serving the files, a fee is charged to providers of the marketing content.

Ricci discloses that collecting royalties without charging subscription fees is an alternative form of levying fees. Ricci actually discloses that the royalty may be a traditional charge (i.e. subscription fees or any other form of charging a user) (00 30). Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Janik teaches Subscription is defined to mean a content service whereby new content is periodically provided based on a content selection parameter, such as a particular artist, editorialist, or genre. Subscription services may be paid for by the user or can be ad-supported (free to the user). An example of a subscription service is an audio sports news file that is downloaded to a user's PC every day (see at least 0044-00445, 0065, 0083-0084). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Ricci and include providing clients subscription based content on a regular basis as taught by Janik, because it provides clients with their desired content on a predictable scheduled timeframe easily and conveniently onto their computer.

Ricci fails to disclose charging a fee to providers of the subscription-based content for serving the subscription-based content. As stated above, Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Ferguson et al. teaches levying fees on content providers for transactions with the users (C. 4, lines 53-60). Moreover, Ferguson et al. teaches users of the system receive periodic updates; levying fees on content providers for transactions with the users; paying users of affiliate servers for serving the files, and finally teaches charging marketing content providers a fee (C. 15, lines 7-11; C. 4, lines 53-60; C. 14, lines 30-31; C. 9, lines 2-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service by generating a predictable revenue stream. Also, paying owners of affiliate servers because paying owners of the affiliate servers would increase retention of the affiliate server owners.

10. Claims **7-8, 15-16** and **23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricci view of Janik and Ferguson et al as applied to claims **1, 9** and **17** above, and further in view of Applicants admission of the prior art.

As per **Claims 7, 15, and 23**, Ricci fails to disclose a method of charging a fee from the

provider of the marketing content based on a cost per click. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per click as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per click is admitted prior art.

As per **Claims 8, 16, and 24**, Ricci fails to disclose a method of charging a fee from the provider of the marketing content based on a cost per acquisition. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging a fee from the marketing content provider based on a cost per acquisition as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

As per **Claim 25**, Ricci discloses a method and system comprising:

- (b) allowing the client nodes to subscribe to one or more of the content files (0057, 0061);
- (f) charging the user accounts of the client nodes that received fee-based subscription content files (0022, 0053).

Ricci fails to disclose: (a) receiving content files from at least one content provider, the content including free subscription content files, fee-based subscription content files, and marketing content files; (c) periodically delivering the particular content files to respective clients nodes that subscribed to the particular content files; and (d) charging the content provider a fee for delivering the content files to the client nodes over the network. Ricci discloses that collecting royalties without charging subscription fees is an alternative form of levying fees. Ricci actually discloses that the royalty may be a traditional charge (i.e. subscription fees or any other form of charging a user) (00 30). Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Janik teaches Subscription is defined to mean a content service whereby new content is periodically provided based on a content selection parameter, such as a particular artist, editorialist, or genre. Subscription services may be paid for by the user or can be ad-supported (free to the user). An example of a subscription service is an audio sports news file that is downloaded to a user's PC every day (see at least 0044-00445, 0065, 0083-0084). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Ricci and include providing clients subscription based content on a regular basis as taught by Janik, because it provides clients with their desired content on a predictable scheduled timeframe easily and conveniently onto their computer.

As stated above, Examiner notes that Ricci does disclose charging a fee based on a quantity of content served, Ricci states that the royalties (fees) are based on the number of uses (quantity is equivalent to the number of uses) (00 53). Further, Ferguson et al. teaches levying

fees on content providers for transactions with the users (C. 4, lines 53-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ricci and charge a fee to subscription-based content providers for transmitting their content as taught by Ferguson et al. because charging users and content providers a fee would greatly increase profitability of the file sharing service by generating a predictable revenue stream.

Ricci fails to disclose charging the content provider a fee for the marketing content files based on a number of users that access the marketing content files once downloaded. However, Applicant discloses that this feature is old and well known, see Specification, Page 11, lines 8-11. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Ricci and include charging content provider a fee based on the number of users to access the content as disclosed by Applicant. By Applicant's own admission, the feature of charging a fee from the provider of the marketing content based on a cost per acquisition is admitted prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FADEY JABR whose telephone number is (571)272-1516. The examiner can normally be reached on Mon. - Fri. 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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